IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:		Basil Naji et al.
Serial No.	:	10/090,561
Filing Date	:	March 4, 2002
Group Art Unit	:	1793
Confirmation No.		5549
Examiner	:	Marcantoni, Paul D.
For	:	Coatings for Building Products and Methods of Making Same

VIA EFS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION FOR WITHDRAWAL OF THE RECORDED TERMINAL DISCLAIMER (SUBMITTED UNDER 37 C.F.R. 1.182)

Dear Sir:

Applicants submit this Petition for Withdrawal of the Recorded Terminal Disclaimer in order to nullify or otherwise cancel the effect of a recorded terminal disclaimer that was erroneously filed before a patent issues. As such, this paper respectfully requests nullification of a recorded terminal disclaimer by way of petition for the reasons set forth below as allowable [see *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968)].

A terminal disclaimer was submitted erroneously on or about June 23, 2005, with pending U.S. Patent Application No. 10/090,561 (hereinafter "the '561 application") to disclaim terminal parts of U.S. Patent No. 6,346,146 (hereinafter "the '146 patent").

Applicants' respectfully request the terminal disclaimer be canceled or otherwise nullified.

The rejection as nonstatutory-type double patenting

A nonstatutory-type double patenting rejection was presented during prosecution of the '561 application in an Office Action mailed December 23, 2004. In the Office Action, it was stated that the '146 patent did not have identical conflicting claims but "they are not patentably distinct from each other because all teach compositions comprising cement and fly ash and water in amounts overlapping the instantly claimed invention and process of making as well."

Claims of the pending '561 application

The '561 application, as claimed, is directed to a method of improving a hydraulic binder based coating formulation for coating a building board, the method comprises adding to said hydraulic binder a dewatering agent and water (see all allowed claims, Claims 1-9, 12, 16-20). After application of a thin slurry of the coating formulation to a building product, said slurry is dewatered through the building product (see all allowed claims, Claims 1-9, 12, 16-20). The thin slurry is 0.1 to 10 mm thick (Claims 1-9, 12, 16-19), is dewatered in at least about 120 seconds or less (Claims 16, 20). The thin slurry applied to the building product cures in air in at least about 48 hours (Claim 17).

In Claims 1-9, 12, 16-17 and 20, the dewatering agent comprises fly ash, wherein the fly ash further comprises two components with:

- a first larger size component of a 100 micron maximum size in an amount of about 10 to 60 wt% of the formulation based on total dry ingredients; and
- a second smaller size component of about 10 micron maximum size in an amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients.

In Claims 18 and 19, the dewatering agent comprises fly ash, wherein the fly ash further comprises two components with:

- a first larger size component of greater than 100 microns; and
- a second size component of about 10 micron maximum size in an amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients.

Claims of the '146 patent

Claims of the '146 patent are for methods for forming an autoclave cured cementitious product (Claims 1-33, 65, 71-78), a formulation for preparing a cementitious product (Claims 34-62, 66, 68-70), and a cementitious product of an autoclave cured reaction of the formulation of claim 34 or an autoclave cured reaction method of claims 33 or 65 (Claims 63, 64, 67).

The methods and formulations for the cementitious product must comprise a cementitious material, a siliceous material and a material comprising substantially calcium silicate hydrate in water to form a slurry (all claims, Claims 1-78). The slurry is formed into a green shaped article and the green shaped article requires curing in an autoclave (Claims 1-33, 63, 64, 65, 67, 71-78). The green shaped article is formed from a slurry by the Hatschek process (Claim 5, 65), filter process (Claim 6), injection moulding (Claim 7), extrusion (Claim 8).

The calcium silicate hydrate required in all formulations and products of the '146 patent are produced by the same reaction, a reaction of a siliceous reactant and a calcareous reactant in water (all claims, Claims 1-78). The reaction occurs under pressure (Claims 15, 16, 65) and at an elevated temperature (Claim 65), between 120 and 250 degrees C (Claim 13) or between 160 and 180 degrees C (Claim 14), for less than 4 hours (Claim 10, 74) or up to 2 hours (Claim 11, 65, 75). The substantially calcium silicate hydrate formed by the reaction just described has a low bulk density of between 0.06 and 0.3 g/cm^2 (Claims 2, 35) and is added in sufficient quantity to the cementitious product so the resultant cementitious product has a low bulk density between 0.5 and 1.2 g/cm^2 (Claims 33, 40, 65, 66, 78).

The '146 patent does not claim a dewatering agent, two fly ash sizes and overlapping amounts, a coating, or a thin slurry

The '146 patent discloses nothing about a dewatering aid that comprises fly ash. In fact, the term "dewatering aid" appears nowhere in the specification or claims of the '146 patent. The '146 patent does not claim fly ash in amounts overlapping the '561 application. The '146 patent also does not claim two components of fly ash in overlapping amounts in a formulation for coating a product, wherein the coating is a thin slurry of 0.1 to 10 mm thick. Claims of the '146

patent are not directed to a coating. Rather, claims of the '146 are for methods and formulations for cementitious products that specifically form green shape articles after curing by an autoclave. None of the cementitious products of the '146 patent are coatings for a building board nor are they said to be a thin slurry of 0.1 to 10 mm thick, air dried for at least about 48 hours.

Accordingly, claims of the '561 application are patentably distinguishable from those of the '146 patent. Thus, the '146 patent does not anticipate and is not obvious over the '561 application and cannot be relied on for an obviousness-type double patenting rejection because claims of the '146 patent neither teach nor suggest the claimed subject matter of the '561 application or are an obvious variant thereof.

The specification of the '146 patent may be used to understand the meaning of terms in the claims

The specification can be used as a dictionary to learn the meaning of a term in the patent claim. [*Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999)].

To understand the meaning of the term cementitious product in the '146 patent, the specification is referred to wherein it is described, at Col. 2, ll. 6-10; Col. 3, ll. 23-56, Col. 5 and Col. 6, Example 2, Example 4, Example 6, Example 7, Example 8, and Col. 16, ll. 3-8, that cementitious products are thicker low density building products and the calcium silicate hydrate is used to lower the density of the building product to a density similar to timber. The building products described by the '146 patent are thick, for example 10-35 mm, and include panels and sheets, timber trim replacements, siding, fascias, roofing, eave sheets. Col. 2, ll. 24-62 describes the cementitious products, formed as green articles, require curing by autoclaving.

To understand the meaning of the term calcium silicate hydrate in the '146 patent, the specification is referred to wherein it is described, at Col. 2, ll. 35-39, that calcium silicate hydrate is a low bulk density material made up of particles being substantially calcium silicate hydrate; the particles are in the form of a 3-D interlocking structure as beads and are resistant to crushing in subsequent processing steps. Hence, the low bulk density calcium silicate hydrate is a formed structure in the form of a 3-D interlocking bead.

Conclusion

The '146 patent does not have identical conflicting claims to the '561 application. The '146 patent is also patentably distinct from '561 application because the '146 patent does not teach the same composition as claimed in the '561 application that comprises fly ash in two components, the '146 patent does not teach overlapping amounts of fly ash as claimed with the '561 application, the '146 patent does not teach the same process of making the composition of the '561 application.

Nullification or cancellation of the recorded terminal disclaimer erroneously submitted before the patent issues—for the terminal disclaimer directed to U.S. Patent No. 6,346,146—is herewith respectfully requested.

Applicants with this Petition submit the fees due under 1.182 and 1.17(f).

Should additional fees be due to grant nullification of the recorded terminal disclaimer, Applicants authorize the Commissioner to withdraw said fee, which is only for the grant of a nullification, to Gardere Wynne Sewell, Deposit Account No. 07-0153.

Respectfully submitted,

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Dated: February 26, 2009

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